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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,389	09/28/2005	Michael Bauer	2732-168	6518
6449 7590 07/21/2010 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER AMAKWE, TAMRA L				
ART UNIT		PAPER NUMBER		
1785				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

### Office Action Summary

**Application No.**

10/531,389

**Applicant(s)**

BAUER ET AL.

**Examiner**

TAMRA L. AMAKWE

**Art Unit**

1785

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-10 and 12-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over: 1) claims 8-27 of US 7357077 (Adamczyk ) in view of US 6,060,143 (Topkin et al.); 2) claims 1-24 of US 20080290647 (Adamczyk , the corresponding application 11/979107 is now patented, yet to receive a number) in view of US 6,060,143 (Topkin et al.); and 3) US 7311043 (Mayer et al.) in view of US 6,060,143 (Topkin et al.)**

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims contain tactile perceptible print, however,

the patented claims have embossed and intaglio printed areas and thus are the same to the touch. The patented claims are absent a foil with gaps applied to the carrier.

However, Topkin teaches a data carrier (shown in Figs. 2, 5, 7, 9, and 11-12 and associated text) comprising a discontinuous cover layer 9 (reflective material and thus considered a foil) creating windows (gap) covering microscopically fine (embraces ranges of 5-100 or 500 microns ) relief structure 15 in part and the relief is on a carrier (3). Note at least two relief structure areas are taught. See at least abstract, 3:45-68, cols. 8 and 9, and 6:10-20 to embossing features, and patented claims 1-17. Topkin does not explicitly show a print layer but teaches a print layer, covers the relief in order to avoid undesired, visually perceptible diffraction effects at the relief structures 15. See 4:25-30.

Thus the areas where and where not are printed and embossed are tactilely perceptible. See also 4:20-45, 6:15-50. It would have been obvious to use the specific resin material for the cover over the relief print to protect it and still enable feel as the gaps make it so.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-6, 8-10, and 12-16 are rejected under 35 U.S.C. 103(a) as obvious over Schell (US 6,098,546) in view of Topkin et al. (US 6060143).**

**Re Claims 1, 6, and 13-16:** Schell teaches a data carrier (paper for securities) printed via intaglio print. See 1:15-55, 2:10-15, 3:1-25. The intaglio print provides a relief structure which is discernible to touch (1:25). This is equivalent to a tactile perceptibility. Schell discloses it is a well known to traditionally print on paper with intaglio print (re claims 1 and 16). Thus the areas printed and embossed are tactilely perceptible. Schell clearly states that the relief print from intaglio printing produces ink that is approximately 20 microns thick. This range falls into Applicant's range of approximately 5 to 100 microns (claims 1 and 16.) Schnell goes on to state the relief is discernible to touch, usually having a height of 40 microns from approximately 20 micron thick ink layer and a 20 micron embossing (See 1:15-55, especially lines 25 and 43-46. See further 2:10-15, 3:1-25.) The improvement of Schell relies upon the higher speeds of the print rollers which deforms the surface of the paper (therefore this process imprints the paper) to yield high register accuracy with expensive OVI inks.

Schell does not teach a foil over the imprint.

Topkin teaches a data carrier, such identification cards (shown in FIGs. 1-2 and associated text). These comprise a discontinuous cover layer 9 (reflective material and thus considered a foil –see 2:57) creating windows (gap 7, FIG. 1. Gap 16 and 17, Fig. 2.) It covers the microscopically fine (embraces micron range) relief structure in parts. The

relief is on carrier (3). At least two relief structure areas are taught (see 5 and 6 of Fig. 1 and 2:25-30 and Fig. 2 upper and lower sides of carrier 3. See at least Abstract, 3:45-68, cols. 8 and 9, 6:10-20 to embossing features, and patented claims 1-17.) Topkin also teaches a print layer covers the relief in order to avoid undesired, visually perceptible diffraction effects at the relief structures 15 (See 4:25-30, 6:15-50.)

It would have been obvious to one having ordinary skill in the art to have modified the security of Schell by including a foil partially on non-covered and covered printed areas to maintain tactile perceptibility because Topkin teaches the gaps created by the discontinuous cover foil is not only protective, but reflects light at different angles to aid in further providing a security feature to identification card data carriers (see citing of Topkin above).

**Re claim 2:** the printed area contains blind-embossed areas because no ink is present in between where ink is present, (See roller 3 in the Figure. See 4:1-25.)

**Re claim 3:** the non-covered area functions as claimed as set forth above.

**Re claims 4 and 14:** The foil has at least one gap or window in it as set forth above.

**Re claims 5 and 10:** Regarding claim 5, the film is considered to have a not very pronounced surface relief.

Regarding claim 10, the printed area is considered to have a pattern which extends essentially seamlessly between the area covered with film and the uncovered area.

Because Schell teaches the ink layer thickness are metered by modulation of frequency of the screen printing mesh holes to yield more or less holes, the surface relief printed area thickness is a result effective variable.

It is obvious to shape or size it also dependent upon how much concealing is desired. The optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made. It has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. See MPEP § 2144.05 II (B).

**Re claim 6:** identification cards are taught as a carrier as set forth above. (See identification card 13, Fig. 1, Topkin.)

**Re claim 8:** The foil thickness is not taught to be less than 20 microns. The reference teaches that it is thin (2:55-60).

It would have been obvious to one having ordinary skill in the art to have modified the security combination by altering the thickness of the foil to effectively conceal or reveal the underlying relief for more or less protection dependent upon the desired areas to cover as taught by Topkin. This modification aids in effecting the feel and optical viewing properties aiding in security measures as cited above.

**Re claims 9 and 10:** The pattern of the reference is considered to be a finely structured pattern (embraces design patterns such as guilloches).

**Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schell (US 6,098,546) in view of Topkin et al. (US 6060143) as applied to claim 1 above, and further in view of US 6,474,695 to Schneider et al.**

The combination is set forth above.

**Re claim 7**, the combination does not teach holographic embossed structures.

Schneider teaches security bank notes and ID (identity) cards having optically effective structures such as embossed holograms or diffraction or relief structures to affect the different viewing angles and coloring, (See 3:25-41, 4:1-55, col. 6 and col. 11.)

It would have been obvious to one having ordinary skill in the art to have modified the combination to include holograms or surface reliefs as claimed because Schneider teaches that holographic embossed structures add to differing angles and coloring of a security document as cited above.

**Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schell (US 6,098,546) in view of Topkin et al. (US 6060143) as applied to claim 1 above, and further in view of Roule (US 4715623).**

**Re Claim 2:** If the combination is not considered to teach a blind-embossed area because the reference does not expressly state the embossing areas are "blind-embossed" the following rationale is noted.



Roule teaches unlinked areas of intaglio plates (is otherwise known as blind embossing) to provide contrast and concealed identifier to a paper. See at least Abstract, and cols. 1-2. It would have been obvious to one having ordinary skill in the art to have modified the combination to include blind embossed areas because Roule teach they add further depths of security as cited above.

### *Response to Arguments*

Applicant's arguments and amendments have been fully considered. The prior rejections are withdrawn. The Applicant's remarks are based on the amendments to the claims and considered moot in view of the new ground(s) of rejection.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and

any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. AMAKWE whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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